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PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q63327

Moshe WEINER, et al.

Appln. No.: 09/892,767

Group Art Unit: 2837

Confirmation No.: 3418

Examiner: Marlon T. FLETCHER

Filed: June 28, 2001

For: TELE-KARAYOKE

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated August 9, 2006. Entry of this Reply Brief is respectfully requested.

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REPLY BRIEF
U.S. Appln. No. 09/892,767

STATUS OF CLAIMS

All claims 1-42 are rejected.



REPLY BRIEF

U.S. Appln. No. 09/897,766

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-13, 15, 18, 20-25, 27, 30, 31 and 33-39 are unpatentable under 35

U.S.C. § 103(a) over Catona (6,288,319) in view of Landante et al. (5,555,017).

2. Whether claims 14, 16, 19, 20, 26, 28 and 29 are unpatentable under 35 U.S.C. § 103(a) over Catona in view of Landante, and further in view of Lewis (5,564,001).

3. Whether claims 17, 32 and 40-42 are unpatentable under 35 U.S.C. § 103(a) over Catona in view of Landante et al. and further in view of Liu (5,953,005).

ARGUMENT

Independent claims 1, 20, 34, and 35 are each rejected as obvious over Catona in view of Landante. Specifically, the Response to Arguments section¹ of the Examiner's Answer acknowledges that Catona does not disclose using an MMS (multimedia message server) message. Therefore, the Examiner looks to the MMS server of Landante in an attempt to make up for this deficiency.

Catona discloses an electronic greeting card in which a karaoke performance can be saved as an e-mail attachment or stored on a server 16 with a hyperlink embedded in the e-mail.² The Examiner alleges that it would have been obvious to modify the electronic greeting card of Catona so that the karaoke performance is instead saved as an MMS message, such as that disclosed in Landante, in order to allow "the transmission to be used by a device that utilizes MMS messages, such as a cellular phone."³

As an initial matter, this asserted motivation appears to be based on hindsight because *neither* Catona nor Landante discusses the benefits of recording a karaoke performance using a device that utilizes MMS messages, such as a cellular phone.⁴ In contrast, the specification of

¹ See Examiner's Answer dated August 9, 2006 at page 6, line 11.

² See Catona at 3:41-50.

³ See Examiner's Answer at page 7, lines 14-17.

⁴ See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 19991); MPEP § 2143 & 2143.01.I (pg.

the present application provides an explanation of the benefits of recording a karaoke performance as an MMS message.⁵

Moreover, Landante only generally discloses that MMS messages have been used to transmit various multimedia. That is, Landante does not discuss the recording of a selected song and user's voice *together* as an MMS message, which would be required to record a karaoke performance. In fact, Landante only generally refers to the audio component of an MMS message⁶ and only discloses combining audio, video, and/or data together, and does not disclose combining the two distinct audio media of a karaoke performance, a song and a user's voice.⁷

Therefore, Applicant respectfully submits that there is no combination of Catona and Landante that would reasonably teach or suggest all of the independent claims' recitations. Accordingly, Applicant respectfully requests that the Board reverse all of the Examiner's rejections.

⁵ See Original Specification at page 4, para. [0010].

⁶ See Landante at 4:19-20, 4:52-54, 5:21-23, 5:35-40, 5:47-51, etc.

⁷ See Landante at 5:15-18.

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CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.


Respectfully submitted,

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